

REMARKS

Introduction

Claims 1 to 18 and 69 to 90 are currently pending, and stand rejected. Claims 19 to 68 were previously withdrawn from consideration. Claims 69 and 90 have been amended to provide proper number agreement between the use of "the instruction" and its antecedent basis "a plurality of instructions" which was added in the previous amendment. The present amendment is supported by the original disclosure. No new matter has been added. The amendment is not believed to raise new issues for search or require additional consideration; accordingly, entry of the amendment is respectfully requested.

In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

Rejection of Claims 1-6, 10-15, 69, and 84-90 over Irwin in view of Wilz

Claims 1-6, 10-15, 69, and 84-90 stand rejected under 35 U.S.C. § 103 over Irwin in view of Wilz. Applicant respectfully disagrees with the rejection for the following reasons.

To establish a prima facie case of obviousness, the Office Action must demonstrate three criteria: (1) there must be some suggestion or motivation to one of ordinary skill in the art to modify a reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest each and every limitation in the claim under examination. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

The proposed combination does not teach or suggest all the features of Applicant's claim 1. Claim 1 recites:

1. A method for validating a ticket associated with a game of chance, comprising:
reading *a barcode encoded with data and a first program* comprising a plurality of instructions, wherein the barcode is included on the ticket;
based on the encoded first program, sending the data and a trigger to execute a check validity program to validate the data; and
responsive to a determination of the data being valid by the check validity program, validating the ticket.

The Office Action admits that Irwin does not teach the recited program encoded in the barcode, and proposes a combination with Wilz to correct this deficiency.

As an initial matter, Applicant disagrees that the features described in Wilz constitute the claimed "first program comprising a plurality of instructions" that is recited in Applicant's independent claims 1, 10, and 69. Applicant disagrees that the feature cited by the Office Action from Wilz that involves writing a single browser input would be reasonably interpreted as a **program with a plurality of instructions** by an ordinary artisan.

Moreover, Applicant respectfully submits the proposed combination of Wilz and Irwin is improper. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". *KSR v. Teleflex*, 550 U.S. ___, 82 USPQ2d at 1396. The Office Action proposes a combination of Wilz with Irwin, proposing that Wilz invocation of a website address should be included in Irwin's bar code. There is no explanation of how Irwin's bar code could actually be made to function using Wilz approach. To the extent the proposed combination is understood, the proposed combination appears to totally alter the operation of Irwin without explanation of how or why this combination would be made to work. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP 2243.01 (citing *In re Ratti*, 270 F.2d 810 (CCPA 1959)).

To the extent the proposed combination is understood, the Office Action is not believed to provide any evidence of how an ordinary artisan would be lead by common sense to the approach suggested in the Office, because Irwin's system already verifies Irwin's ticket using Irwin's existing bar code. Thus the combination is not believed to provide the purported benefits suggested in the Office Action. The Office Action asserts that the combination would be made "in order to quickly instigate an actions of verification without the need to go through complicated systems by directly providing instruction on the barcode that leads to the validation program". But Irwin's system already provides direct access to Irwin's validation program which is provided in Irwin's terminal. Accordingly, the proposed combination would not be tried by an ordinary artisan using common sense. Rather, the only reason to make such a combination appears to be to pick and choose features in an attempt to provide all the features of Applicant's claim 1. This sort of hindsight reconstruction cannot be used to make out a proper *prima facie* case of obviousness.

Moreover, Wilz teaches away from the proposed combination, as Wilz suggests that even encoding simple URL addresses are the limit of what is possible in his system, since he suggests that special coding techniques are needed even to accommodate just URLs. See, e.g., Wilz 12:40-46. This suggests that an ordinary artisan consulting Wilz would not be lead, and in fact would be lead away from contemplating the inclusion of full-fledged programs in bar codes based on the teachings of Wilz.

Claims 2-5 and 84 -88 depend from claim 1 and therefore should be allowable for at least the same reasons given above for claim 1.

Separately and independently from the above, Claim 2 recites "the data is an identifier associated with the ticket". The Office Action, at page 4, second full paragraph, asserts that Irwin teaches "the data is a validation number, which is an identifier associated with the ticket". But earlier, in the rejection of claim 1, the Office Action asserts that "the data" is Wilz' URL. Accordingly, it is not understood how the proposed combination is supposed to provide all the features of Applicant's claim 2. The Applicant respectfully notes that combinations that change the operating principle of the references or that render the base reference inoperable cannot form the basis for a prima facie case of obviousness. Accordingly, Applicant respectfully submits that no proper prima facie case of obviousness has been made for claim 2, and the rejection should be withdrawn. At minimum, Applicant is unable to respond to the proposed combination, because it is not understandable, and accordingly further clarification is required. The rejection of claim 11, which is the same of the rejection of claim 2, should be withdrawn for the similar reasons.

Separately and independently, claim 3 recites "processing the data using the executed check validity program". The Office Action, at page 4, third full paragraph, asserts that Irwin discloses this feature, because Irwin uses "the matching play indicia value data". But the data in claim 1 is alleged in the Office Action to be the URL from Wilz. Accordingly, the proposed combination does not appear to be operative, or follow common sense. Accordingly withdrawal of the rejection of claim 3, or at minimum further detailed clarification, is respectfully requested.

Separately and independently, claim 4 recites "based on the encoded first program, connecting to a remote terminal". The Office Action, at page 4, fourth full paragraph, asserts

that this feature is taught by Irwin. But elsewhere, as discussed above, the Office Action admits that the first program instruction is entirely absent from Irwin. To the extent the rejection is understood, it is not believed to provide any evidence of how any feature of Irwin can teach that a connection is "based on the encoded first program." Accordingly, withdrawal of the rejection of claim 4 is respectfully requested.

Separately and independently, Applicant's claim 84 recites "based on the encoded first program, choosing a network server". However, in the combination proffered in the office action, the URL in Wilz is the data, not part of the program. Accordingly, even if the proposed combination were as described in the Office Action, the recited feature of claim 84 has not been identified in the combination of cited references. Claim 84 should be allowable for at least this addition reason.

Similarly, claim 86 recites "choosing a network address" "based on the encoded program". In the Wilz reference as described by the Office Action, the Wilz' URL is the data, not part of the program code. Accordingly, all of the features have not been identified in the cited references, and the rejection is believed to be improper. Claim 87, which depends from claim 86, should be allowable for at least the same reason.

Independent claim 10 should be allowable for reasons similar to those given above for claim 1, both the discussion regarding the "program", and the discussion of the proposed combination of Irwin and Wilz. Moreover, claim 10 recites "the remote terminal to receive the data ... from the local terminal", and the check validity program is executed "at the remote terminal". However, in the proposed combination put forward by the Office Action, the recited "data" is alleged to be Wilz' URL. However Wilz URL is not sent to a server nor is it used to execute a check validity program at a remote terminal. Rather Wilz URL is used to choose a location on the Internet for the Wilz terminal to access – it is an address where data might be accessed, not a message sent to a remote terminal. Accordingly, the proposed combination, even if it were arguably proper, does not include all the features of Applicant's claim 10 for at least this additional reason.

Claims 11-15 and 89 depend from claim 10 and therefore should be allowable for at least the same reasons as those given above for their parent claim.

Independent claim 69 should be allowable for similar reasons to those discussed above for claim 1, namely that the Wilz reference does not teach the recited program, and the combination of Wilz and Irwin is improper. Claim 80 depends from Claim 69 and therefore should be allowable for at least the same reasons.

For at least the above reasons, Applicant respectfully submits that the rejections under 35 U.S.C. § 103 of Claims 1-6, 10-15, 69, and 84-90 should be withdrawn.

Rejection of Claims 74, 78, and 82 over Irwin in view of Wilz and Poland

Claims 74, 78, and 82 depend from claims 1, 10, and 69 respectively and therefore should be allowable for at least the reasons given above for their respective parent claims. Poland does not correct (and is not purported by the Office Action to correct) the deficiencies of Irwin combined with Wilz with respect to the parent claims.

Moreover, the Office Action posits that Poland would be combined with Wilz and Irwin "in order to ensure that the instructions provided by the bar code can be properly executed, which avoids any erroneous operation". However regarding the reading of a barcode encoded with a program comprising a plurality of instructions, the Poland reference only discusses reading a single instruction at a time. That is, the Poland reference never reads a plurality of instructions of a program from a single barcode. Instead, the Poland reference either reads a single instruction in a single barcode, or else actually requires reading multiple barcodes to obtain only a single instruction. See, for example, Poland col. 6, line 60, to col. 7, line 63, and col. 8, line 48, to col. 9, line 54, which in part reads as follows (emphasis added below):

... there are three different types of commands. The first type is a single scan command that includes a memory manipulation opcode, an address and an argument to complete a configuration selection. The second type of command requires two scans, a memory manipulation opcode with an address, followed by a separate numerical or single character argument to complete a configuration selection. The third type of command requires multiple scans, a memory manipulation opcode with an address, followed by a string of single character arguments from separate tags, and is terminated by scanning an end of characters tag. (cols. 6-7)

Thus, the Poland reference never discloses or suggests reading a barcode encoded with a program comprising a plurality of instructions.

Furthermore, the Poland reference even effectively teaches away from the proposed combination, because Poland teaches away from reading of a plurality of instructions from a single barcode. For example, at col. 7, line 64, to col. 8, line 34, the Poland reference extols the virtues of its simple command set which "conserves memory space in the operating system and provides efficient operation of the interpreter" (lines 21-23). Thus, one of ordinary skill in the art would be dissuaded from the idea of encoding a plurality of instructions on a single barcode based on a fair reading of the Poland reference. That is, if the Poland reference is concerned with reducing the complexity of even a single command read by the barcode reader, one of ordinary skill in the art would surely be dissuaded from attempting to read a plurality of commands at once by such a barcode reader. (The Office is respectfully reminded that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. (*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).)

For at least the above reasons, the rejections of claims 74, 78, 82 should be withdrawn.

Rejection of Claim 7 over Irwin in view of Wilz and Sanders

Claim 7 stands rejected under 35 U.S.C. 103(a) over Irwin in view of Wilz and Sanders. Claim 7 depends from claim 1 and should therefore be allowable for at least the same reasons as those given above for its parent claim. The addition of Sanders does not correct (and is not purported by the Office Action to correct) the deficiencies of the combination of Irwin and Wilz with respect to claim 1.

Separately independently Applicant respectfully submits that the proposed combination would not be operative. The purported "data" in the Office Action is Wilz' URL. If Wilz' URL is invalid, the Office Action's proposed combination system will not be able to access the check validity program at all, and the check validity program will not determine the data to be invalid. Accordingly, the proposed combination is inoperative, and cannot provide all the features of Applicant's claim 7. For at least this reason, Applicant respectfully submits that the rejection of claim 7 should be withdrawn.

Rejection of claims 8, 9, 16, 17, 18, 70 and 71 over Irwin in view of Wilz and Axelrod

Claims 8, 9, 16, 17, 18, 70 and 71 stand rejected under 35 U.S.C. 103 over Irwin in view of Wilz and Axelrod.

These claims should all be allowable for at least the reasons given above for their respective parent claims 1, 10, and 69. The addition of Axelrod does not correct (and is not purported by the Office Action to correct) the deficiencies of the combination of Irwin and Wilz with respect to the parent claims.

Rejection of claims 72, 73, 75-77, 79-81 and 83 over Irwin in view of Wilz and Meyer

Claims 72, 73, 75-77, 79-81 and 83 stand rejected under 35 U.S.C. 103 over Irwin in view of Wilz and Meyer. These claims depend from claims 1, 10, and 69 respectively. Accordingly, they should be patentable for at least the same reasons as their respective parent claims. The addition of Meyer does not correct (and is not purported by the Office Action to correct) the deficiencies of the proposed combination of Irwin and Wilz.

Claim 72 recites "executing the first program with a virtual machine" and claim 73 recites that the first program includes Java virtual machine instructions. Claims 73, 76, 77, 80, and 81 all recite similar features. The Office Action admits that the combination of Irwin and Wilz does not provide these features. While Meyer generally describes a Java Virtual machine and Java program, nothing in Meyer suggests that a Java program should be embedded within a bar code. While the Java platform might arguably be ideal for the Internet, nothing would suggest to an ordinary artisan, other than Applicant's own claimed invention, that a Java program should be provided in a bar code on a lottery ticket.

Claims 75 recites compiling the program which is provided in a bar code. Claims 79 and 83 recite similar features. Nothing cited in the Office Action, other than Applicant's own disclosure, suggests why an ordinary artisan would be lead to compile a program that has been embedded in a bar code. No evidence is provided as to why an ordinary artisan would be lead to apply Meyer's compiler to Wilz' copying of a URL and a carriage return. For at least this reason, Applicant respectfully submits that the proposed combination does not render claims 75, 79, and 83 obvious.

Rejection of claims 8, 9, 16, 17, 18, 70 and 71 over Irwin in view of Wilz and Axelrod

Claims 8, 9, 16, 17, 18, 70 and 71 stand rejected under 35 U.S.C. 103 over Irwin in view of Wilz and Axelrod.

These claims should all be allowable for at least the reasons given above for their respective parent claims 1, 10, and 69. The addition of Axelrod does not correct (and is not purported by the Office Action to correct) the deficiencies of the combination of Irwin and Wilz with respect to the parent claims.

Rejection of claims 72, 73, 75-77, 79-81 and 83 over Irwin in view of Wilz and Meyer

Claims 72, 73, 75-77, 79-81 and 83 stand rejected under 35 U.S.C. 103 over Irwin in view of Wilz and Meyer. These claims depend from claims 1, 10, and 69 respectively. Accordingly, they should be patentable for at least the same reasons as their respective parent claims. The addition of Meyer does not correct (and is not purported by the Office Action to correct) the deficiencies of the proposed combination of Irwin and Wilz.

Claim 72 recites “executing the first program with a virtual machine” and claim 73 recites that the first program includes Java virtual machine instructions. Claims 73, 76, 77, 80, and 81 all recite similar features. The Office Action admits that the combination of Irwin and Wilz does not provide these features. While Meyer generally describes a Java Virtual machine and Java program, nothing in Meyer suggests that a Java program should be embedded within a bar code. While the Java platform might arguably be ideal for the Internet, nothing would suggest to an ordinary artisan, other than Applicant’s own claimed invention, that a Java program should be provided in a bar code on a lottery ticket.

Claims 75 recites compiling the program which is provided in a bar code. Claims 79 and 83 recite similar features. Nothing cited in the Office Action, other than Applicant’s own disclosure, suggests why an ordinary artisan would be lead to compile a program that has been embedded in a bar code. No evidence is provided as to why an ordinary artisan would be lead to apply Meyer’s compiler to Wilz’ copying of a URL and a carriage return. For at least this reason, Applicant respectfully submits that the proposed combination does not render claims 75, 79, and 83 obvious.

For at least the above reasons, Applicant respectfully requests the withdrawal of the rejections of claims 72, 73, 75-77, 79-81 and 83.

CONCLUSION

All issues raised in the Office Action are believed to have been addressed. In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Entry of the amendment, and prompt reconsideration and allowance of the present application are therefore earnestly solicited. The Commissioner is authorized to charge any fee arising in connection with the filing of this paper, including any necessary extension of time, to the deposit account of **Kirkpatrick & Lockhart Preston Gates Ellis LLP**, Deposit Account No. **0080570**. The Examiner is cordially invited to telephone the undersigned if any issue or question arises with respect to the present application.

Date: May 27, 2008

Respectfully submitted

By: 

Andrew L. Reibman
Reg. No. 47,893

Kirkpatrick & Lockhart Preston
Gates Ellis LLP
599 Lexington Avenue
New York, N.Y. 10022
(212) 536-3900 (telephone)
(212) 536-3901 (facsimile)
CUSTOMER NO. 00545